

### **REMARKS/DISCUSSION OF ISSUES**

By this Amendment, Applicant amends claims 17, 18 and 23 for clarification. Accordingly, claims 1-35 are pending in the application.

Applicant thanks the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority documents. The Examiner is respectfully requested to state whether the drawings are acceptable.

Reexamination and reconsideration are respectfully requested in view of the following Remarks.

### **OBJECTION TO THE SPECIFICATION**

Applicant thanks the Examiner for providing information about recommended section headings. However, Applicant respectfully declines to add the headings. Section headings are not statutorily required for filing a non-provisional patent application under 35 USC § 111(a), but per 37 CFR § 1.51(d) are only guidelines that are suggested for applicant's use. (See Miscellaneous Changes in Patent Practice, Response to comments 17 and 18 (Official Gazette, August 13, 1996) [Docket No: 950620162-6014-02] RIN 0651-AA75 ("*Section 1.77 is permissive rather than mandatory. ... [T]he Office will not require any application to comply with the format set forth in 1.77*")).

Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to the specification.

### **OBJECTIONS TO THE CLAIMS**

The Office Action objects to claim 24 as supposedly reciting "*a resonant circuits*" and objects to claim 33 as supposedly reciting "*a user-held devices*."

Applicant respectfully traverses these objections and respectfully submits that claim 24 does not recite "*a resonant circuits*" and that claim 33 does not recite "*a user-held devices*." The undersigned attorney has reviewed the entire file wrapper via the Pair Application Information Retrieval (PAIR) system of the USPTO, and has confirmed that Applicant has never presented any version of claim 24 that recites "*a*

*resonant circuits*” or any version of claim 33 that recites “*a user-held devices*.”

Now, the undersigned attorney has noticed that the USPTO’s publication of this patent application does indeed recite “*a resonant circuits*” in claim 24 and “*a user-held devices*” in claim 33. So the undersigned attorney believes that this is why the Examiner erroneously believes that claim 24 recites “*a resonant circuits*” and that claim 33 recites “*a user-held devices*.”

However, this is an error generated solely by the UPSTO and the contract labor it employs to print its patent publications. Therefore, any correction of this error must also lie with the USPTO.

Accordingly, Applicant respectfully requests that the Examiner withdraw the objections to the claims.

### **35 U.S.C. § 112**

By this Amendment, Applicant amends claims 17, 18 and 23 to correct their informalities, while maintaining their original scope.

Accordingly, Applicant respectfully submits that claims 17, 18 and 23 are all now patentable under 35 U.S.C. § 112.

### **35 U.S.C. § 103**

The Office Action rejects: claims 1-2, 4-15, 19-22, 24-33 and 35 under 35 U.S.C. § 103 over Ely et al. U.S. Patent 6,667,740 (“Ely”) and Katabami U.S. Patent 5,528,002 (“Katabami”); claims 3, 16-17 and 34 under 35 U.S.C. § 103 over Ely, Katabami and Stein et al. U.S. Patent 5,365,461 (“Stein”); claims 16 and 18 under 35 U.S.C. § 103 over Ely, Katabami and Teterwak U.S. Patent 5,777,898 (“Teterwak”); and claim 23 under 35 U.S.C. § 103 over Ely, Katabami and Colgan et al. U.S. Patent 6,204,897 (“Colgan”).

Applicant respectfully submits that all of the pending claims are patentable over the cited art for at least the following reasons.

#### **Claim 1**

Among other things, the user input system of claim 1 includes means for

sensing an output provided at a conducting tip due to an alternating voltage source when the conducting tip is in the vicinity of the means for sensing an output.

The Office Action states that Ely discloses “means for sensing an output (31-37 in fig. 3, for example).

However, of course, claim 1 does not merely recite a “means for sensing an output.” Instead, claim 1 recites means for sensing an output **provided at a conducting tip** due to **an alternating voltage source**.

Meanwhile, elements 31-37 in Ely are windings for sensing an EM field through magnetic coupling with Ely’s coil 45 in resonant circuit 45. Sensor windings 31-37 do not and cannot sense an alternating voltage provided at a conducting tip (even **IF** Ely had a conducting tip - which it doesn’t and wouldn’t).

So no combination of Ely and Katabami would ever produce the user input system of claim 1.

Also among other things, the user input system of claim 1 includes a user-holdable device comprising a resonant circuit, means for coupling to ground, and a conducting tip, the means for coupling to ground being coupled to a first side of the resonant circuit and the conducting tip being coupled to a second side of the resonant circuit, the resonant circuit being operable to provide an alternating voltage induced from the alternating magnetic field when positioned in the vicinity of the means for generating an alternating magnetic field.

The Office Action fairly admits that Ely does not disclose user-holdable device having any means for coupling to ground or a conducting tip.

However, the Office Action states that Katabami discloses a user-holdable device having any means for coupling to ground and a conducting tip, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ely’s invention to include means for coupling to ground and a conducting tip “*to achieve a more stable and predictable operation of the tablet.*”

Applicant respectfully disagrees.

The Office Action cites Katabami at col. 1, lines 38-44 as supposedly

supporting the proposed rationale for the proposed modification of Ely. The cited text describes some shortcomings of a system like Ely's that has a pen with a passive circuit and which employs electromagnetic (EM) coupling to the tablet. However, Katabami does not solve these shortcomings merely by adding a means for coupling to ground and a conducting tip to a EM-coupling-type device like Ely's. Such modifications to Ely's device by themselves would accomplish nothing. Instead, Katabami discloses a completely different type of device that has a pen with an active circuit and which employs electrostatic coupling with adjacent grid-like conductors in the tablet. It is this arrangement which produces the benefits that Katabami seeks to achieve. Simply making the modifications proposed in the Office Action of adding a means for coupling to ground and a conducting tip to Ely's EM-coupling-type device – without further changing Ely's device to an electrostatic coupling device with an active-circuit pen – would not provide these benefits (indeed, the conductive tip would serve absolutely no purpose whatsoever in Ely's EM-coupling-type device!). And there is absolutely nothing in Katabami or anywhere else in the teachings of the prior art that would provide a reason or suggestion for such a modification.

Meanwhile, if Ely's device was modified to include the arrangement of Katabami with its active-circuit pen, then the device would no longer have any use for a means for generating an alternating magnetic field, and of course the resonant circuit would be controlled by the active circuit, not by any alternating magnetic field. So such a device could not include all of the features of claim 1. Applicant also notes that such a wholesale modification would be improper under M.P.E.P. § 2143.01(VI) (*"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious"*).

Therefore, Applicant respectfully traverses the proposed modification of Ely as lacking any reason at all that would have been realized by one of ordinary skill in the art at the time the invention was made.

Accordingly, for at least these reasons, Applicant respectfully submits that claim 1 is patentable over the cited art.

Claims 2, 4-15, and 19-22

Claims 2, 4-15, and 19-22 depend from claim 1 and are deemed patentable for at least the reasons set forth above with respect to claim 1, and furthermore because of additional novel features recited variously therein. For example, with respect to claim 4, Ely's winding 31 does not and cannot have a current excited therein by an electric field. Also, with respect to claim 15, the Office Action incorrectly identifies element 4 of Katabami as a coil.

Accordingly, for at least these reasons, Applicant respectfully submits that claims 2, 4-15, and 19-22 are all patentable over the cited art.

Claim 24

Among other things, the user-holdable device of claim 24 includes means for coupling to ground; and a conducting tip.

As explained above with respect to claim 1, Applicant respectfully submits that Ely does not include these features, and there would have been no reason from the prior art for one of ordinary skill in the art at the time the invention was made to have modified Ely to add such features.

Accordingly, for at least these reasons, Applicant respectfully submits that claim 24 is patentable over the cited art.

Claims 25-32

Claims 25-32 depend from claim 24 and are deemed patentable for at least the reasons set forth above with respect to claim 24.

Claim 33

Among other things, the method of claim 33 includes providing an output from an alternating voltage at a conducting tip of the user-held device.

Ely does not include such a feature in its EM-coupling-type device. And for similar reasons to those explained in greater detail with respect to claim 1 above, there is nothing in the cited art that would suggest modifying Ely's EM-coupling-type device to add a conducting tip and to provide an output from an alternating voltage at the conducting tip.

Accordingly, for at least these reasons, Applicant respectfully submits that

claim 33 is patentable over the cited art.

Claim 35

Claim 35 depends from claim 33 and is deemed patentable for at least the reasons set forth above with respect to claim 33.

Claims 3, 16-18, 23 and 34

Claims 3, 16-18, 23 and 34 depend variously from claims 1, 24 and 33. Applicant respectfully submits that Stein, Teterwak and Colgan do not remedy the shortcomings of Ely and Katabami as set forth above with respect to claims 1, 24 and 33. Therefore, the propriety of the proposed modification to Ely's device based on Stein, Teterwak and Colgan is deemed moot at this time.

Accordingly, for at least these reasons, Applicant respectfully submits that claims 3, 16-18, 23 and 34 are all patentable over the cited art.

**CONCLUSION**

In view of the foregoing explanations, Applicant respectfully requests that the Examiner reconsider and reexamine the present application, allow claims 1-35 and pass the application to issue. In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (571) 283.0720 to discuss these matters.

Respectfully submitted,

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